



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/891,287	06/27/2001	Masahiro Kakehi	210098US0	1859

22850 7590 12/24/2003

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

SLOBODYANSKY, ELIZABETH

ART UNIT PAPER NUMBER

1652

DATE MAILED: 12/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/891,287

Applicant(s)

KAKEHI ET AL.

Examiner

Elizabeth Slobodyansky

Art Unit

1652

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 28 August 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 28 August 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 4 and 5.Claim(s) withdrawn from consideration: 9 and 10.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____



Elizabeth Slobodyansky
Primary Examiner
Art Unit: 1652

Continuation of 5. does NOT place the application in condition for allowance because: With regard to the 112, 2nd paragraph, rejection Applicants argue that "in order to show that Escherichia bacteria other than E. coli also have ushA and aphA genes which have high homology to these genes from E.coli, printouts from the DDBJ, which indicate the genes of the following accession Nos., are submitted herewith". This is not persuasive because none of these 6 genes belongs to the species of Escherichia other than coli (2 genes) and 4 genes belong to different genera. Furthermore, the metes and bounds of "high homology" are not defined. With regard to the 102(b) rejection over Laird, Applicants argue that "the 54G2 strain of Laird cannot produce nucleoside 5'-phosphate esters such as inosine 5'-phosphate ester, which is produced via the purine synthesis pathway" (Remarks, page 5). This is not persuasive because it is unknown whether the same purine pathway affects guanosine 5'-phosphate ester. Therefore, claim 5 would remain rejected as drawn to guanosine 5'-phosphate ester. Moreover, pyrimidine pathway is not affected. Therefore, claim 4 as reciting any nucleoside 5'-phosphate ester is anticipated by Laird. With regard to the 103 rejection, Applicants argue that "the reference [Thaller et al] fails to ... suggest that such bacteria would have the ability to produce and accumulate nucleoside 5'-phosphate ester in a medium" (page 6). This is not persuasive because Thaller et al. teach nucleosidase activity of aphA (page 195, Table 1) suggesting that the disruption of the gene would result in accumulation of nucleoside 5'phosphate in a medium. Furthermore, Applicants' arguments with regard to Table 5 and page 32 of the specification are not persuasive because only the data regarding purines are shown therein and there is no information regarding pyrimidines. The amendment overcomes the objection of claim 5.